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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,818	01/14/2004	Corrinne Stern	2003.15	1817
37905	7590	11/10/2005	EXAMINER	
NORTHSTAR NEUROSCIENCE 2401 FOURTH AVENUE SEATTLE, WA 98121			BOCKELMAN, MARK	
			ART UNIT	PAPER NUMBER
			3766	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/707,818	<b>Applicant(s)</b> STERN ET AL.	
	<b>Examiner</b> Mark W. Bockelman	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 14, 16 and 19-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13, 15 and 17- 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-22-2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Species I in the reply filed on 8-19-2005 is acknowledged. The traversal is on the ground(s) that the species are obvious variants of each other. This is not found persuasive because it is not understood as to whether applicant is taking the position that the species are obvious variants over one another or whether they are traversing whether they are obvious variants over one another. Applicant's traversal of the election by original presentation imposed by the examiner concerning newly submitted claims 21-27 is not deemed persuasive. The examiner would have to restart the entire examination process over including searching in areas not previously required for search. Such a procedure would place an undue burden on the examiner at this time.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 10-13, 15, 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cross, JR. USPAP 2002/0128700 or Putz USPN 4,903,702.

Cross shows a device in figure 8 that includes at least two elongated multi-electrode paddles that are interconnected by cross members 34 in the region generally shown as 14. The examiner considers these to be detachable coupling members as they are capable of being severed and thus capable of being detachable. The electrodes consist of contacts having layer 20 and tube member 30, which is wrapped with wire 22, all of which are carried by a support member 24 having a backing material 34, which are flexible. The support member as shown in figure 11, has apertures at each end to support contact portion 30 as well as an aperture in the middle of the support material that supports the middle section of 30 and thus the surface 20 as well. The electrodes have a contour shape and the examiner considers the elongated electrode sections connected by wires to form a single formed structure. These "single" formed electrodes have a major and a minor axis with the minor axis having a recessed waist portions in the form of indentations for allowing the electrodes to be articulated with respect to one another. Each of the cross member coupling members have a smaller volume than the multi-electrode paddles. Concerning claim 9, different size paddles are present since they can possibly be formed by severing the connecting structures 34 along different, asymmetrical locations, i.e. closer to one paddle than the other. With respect to claim 10, each of the electrodes have different dimensions as far as their diameter versus their thickness. Claim 10 does not require that the two electrodes have different dimensions with respect to one another. Regarding claim 15, the examiner considers the most distal 18 to be a visible indicator corresponding to its length. The examiner considers the coupling members to have detachment portions

such as at the indentations which serve as a separation mechanism similar as in applicant's elected species 1 Figures 31

Putz shows a similar configuration in figure 5 with "two paddles" that are joined along a reduced waist portion (top to bottom) that can be severed into different paddles. Apertures support contacts with wiring sandwiched in between layers.

Claims 1, 5, 6, 8 -13, 15, 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Feingold USPN 4,233,987. Feingold is interpreted similarly to Cross. Each set of paddles ( 4 members 115, with two forming one paddle and two forming a second paddle. Each has a contoured shape. Various axes can be selected including a minor width and major length. With respect to claim 9, a element device as shown in figure 2 would yield two different paddle sizes with one paddle having two members 15 and the other having a single member. The electrode contacts have different dimensions as far as diameter and thickness. Contacts at the end of the wires would provide a visible indicator according to the lead length. A decoupling mechanism is shown in the form of perforations.

### ***Response to Arguments***

Applicant's arguments filed 4-22-2005 have been fully considered but they are not persuasive. Applicant attempts to distinguish over Feingold by reciting intended use, however there is no reason to suggest that Feingold does not have dimensions that can be used in a neuro anatomical region , such as nerve emanating from the spine, or have

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the ability to be implanted in the body. Such patch type electrodes are frequently placed as epicardial patches on the heart.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.

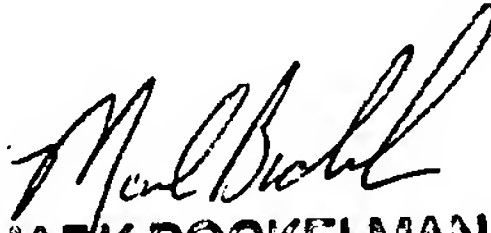
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

October 31, 2005

  
MARK BOCKELMAN  
PRIMARY EXAMINER